

REMARKS

Amendments

In the prior Decision the Board reversed the enablement rejection, but affirmed the written description rejection based on the claim term “foreign ligand”, a phrase to which the Board assigned more functional significance than we intended. In an effort to avoid that construction, we have amended to claim to recite a small organic compound (e.g. Specification, p.6, line 8). These amendments introduce no new matter.

35USC112, first paragraph (written description)

The claims are directed to a method of changing a functional surface binding specificity of a selected PAS domain by (a) contacting the PAS domain with a compound, wherein the compound enters the hydrophobic core of the PAS domain; and (b) detecting a resultant change in the functional surface binding specificity of the PAS domain, wherein the PAS domain is HIF2a PAS B....

As explained in the Specification, suitable foreign ligands may be screened from libraries of synthetic or natural compounds, and conventional SAR analyses provide ligands of higher affinity and/or specificity (Specification, p.6, lines 9-10). This process was specifically exemplified with HIF2a PAS B, wherein a library of 772 compounds (Specification p.13, lines 6-14) was screened for HIF2a PAS B binding using ¹H/¹⁵N-HSQC NMR; as seen in Figure 1, 21 hits were obtained for HIF2a PAS B (see also, Specification, p.18, line 1).

While the structures of two of these hits were later determined (shown in Table 3 and Fig. 3B), the method would be no less enabled and described if the inventors had not bothered to ascertain the structures of these two leads. The method was developed and validated without any structural information about the “compound”; hence, the claim does not require, and the practitioner does not require, any structural information about the recited “compound” to practice the method. As demonstrated, the method is typically practiced using a library of compounds wherein the practitioner is blind and indifferent to the structures of the compounds.

35USC103(a)

In the prior Decision, the Board determined that we did not present sufficient evidence to overcome a prima facie case of obviousness; the attached declaration is submitted to provide such evidence.

The Examiner is invited to call the undersigned with any suggestions for amending the claims or further clarifying any of the foregoing. Please charge any required fee for this communication to our Dep. Acct. No.19-0750 (order UTSD:1510-1).

Respectfully submitted,
Science & Technology Law Group

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Enc. Gardner Declaration dated Sep 15, 2008.

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